

In re: Appln No. 09/707,685  
Amendment dated February 6, 2005  
Reply to Office action of August 5, 2004

Atty Docket: 6006-015

**Remarks**

Applicant's gratefully acknowledge the Examiner's indication that the substitute specification filed July 9, 2004 has been accepted.

Applicant has amended the Specification to claim priority under 35 U.S.C. §120 from co-pending application Serial No. 10/994,770 filed November 22, 2004, which is a continuation of Serial No. 09/745,304 filed December 22, 2000, now U.S. Patent No. 6,820,676, which is a divisional of Serial No. 09/443,929 filed November 19, 1999, now U.S. Patent No. 6,379,383. The claim for priority is timely made pursuant to 35 U.S.C. §120.

The pending claims stand rejected on the following basis:

1. Claims 39-66 are rejected under 35 U.S.C. §102(e) as being anticipated by Whitcher, et al;
2. Claims 39-40, 42, 46-57 and 59-66 are rejected under 35 U.S.C. §102(e) as being anticipated by Johnson, et al.
3. Claims 59-61 and 63-65 are rejected under 35 U.S.C. §102(e) as being anticipated by Clubb, et al.

For the reasons stated below, Applicant respectfully submit that the present amendments further define features of the present invention which are not anticipated nor even remotely suggested by any of the references cited and relied upon in support of the rejections of record.

**I. Whitcher, et al. (U.S. Publication No. US 2003/0018381 A1) is Not Prior Art and Fails to Anticipate the Claimed Invention.**

Applicants respectfully direct the Examiner's attention to the earliest effective filing date of the Whitcher, et al reference which is January 25, 2000. The present application has been amended to claim a priority date relating back to November 19, 1999 for the subject matter claimed in pending Claims 33-53. Specifically, the parent application to the present invention discloses in the specification as originally filed the elements of: a) vacuum depositing a stent-forming metal onto an unpatterned, exterior surface of a generally cylindrical substrate under

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process conditions that controls at least one of grain size and formation of chemical and intra- and intergranular precipitates in the bulk material of a deposited generally tubular, unpatterned<sup>1</sup>; b) defining the plurality of first and second structural elements of the endoluminal stent in the unpatterned metal film<sup>2</sup>; and (c) removing the endoluminal stent from the generally cylindrical substrate<sup>3</sup>. While the priority application does not disclose that control over formation of inter- or intra-granular precipitates, the Whitcher reference is wholly devoid of any teaching that it is known to control deposition process parameters in such a way as to control formation of inter- or intra-granular precipitates in the deposited film.

Thus, Applicants respectfully solicit the Examiner's reconsideration of the reliance upon the Whitcher, et al reference and withdrawal of the rejection under 35 U.S.C. §102(e).

## **II. Johnson et al. (US 6,533,905 B2) is Not Prior Art and Fails to Anticipate the Pending Claims**

Applicants respectfully direct the Examiner's attention to the earliest effective filing date of the Johnson, et al reference which is January 24, 2000. The present application has been amended to claim a priority date relating back to November 19, 1999 for the subject matter claimed in pending Claims 33-53. Specifically, the parent application to the present invention discloses in the specification as originally filed the elements of: a) vacuum depositing a stent-forming metal onto an unpatterned, exterior surface of a generally cylindrical substrate under process conditions that controls at least one of grain size and formation of chemical and intra- and intergranular precipitates in the bulk material of a deposited generally tubular, unpatterned<sup>4</sup>; b) defining the plurality of first and second structural elements of the endoluminal stent in the unpatterned metal film<sup>5</sup>; and (c) removing the endoluminal stent from the generally cylindrical substrate<sup>6</sup>.

<sup>1</sup> See, e.g., U.S. Patent No. 6,379,383, Col. 6, lines 6-42. The '383 Patent is the parent case to the present application.

<sup>2</sup> See, e.g., U.S. Patent No. 6,379,383, Col. 6, lines 40-55; Col. 7, lines 39-41.

<sup>3</sup> See, e.g., U.S. Patent No. 6,379,383, Col. 6, lines 56-65.

<sup>4</sup> See, e.g., U.S. Patent No. 6,379,383, Col. 6, lines 6-42. The '383 Patent is the parent case to the present application.

<sup>5</sup> See, e.g., U.S. Patent No. 6,379,383, Col. 6, lines 40-55; Col. 7, lines 39-41.

<sup>6</sup> See, e.g., U.S. Patent No. 6,379,383, Col. 6, lines 56-65.

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While the priority application does not disclose that control over formation of inter- or intra-granular precipitates, the Johnson reference is wholly devoid of any teaching that it is known to control deposition process parameters in such a way as to control formation of inter- or intra-granular precipitates in the deposited film.

Moreover, the Examiner relies upon Johnson, et al as purportedly teaching a vacuum deposited nickel-titanium film having no less than about 51.5 atomic percent nickel (referencing Col. 4, lines 54-65; Col. 3, lines 25-29 and Col. 5, lines 1-13). A careful review of these sections, however, reveals that the reference is discussing the target composition rather than the deposited film composition. With the exception of the general definition of Nitinol found at Col. 3, lines 25-29, there is no teaching or suggestion in the reference that films of having greater than about 51.5 atomic percent nickel may be obtained by vacuum deposition

Thus, Applicants respectfully solicit the Examiner's reconsideration of the reliance upon the Johnson, et al reference and withdrawal of the rejection under 35 U.S.C. §102(e).

### **III. The Rejection Based Upon Clubb, et al. (U.S. Patent No. 6,203,732 B1) is Moot.**

Applicants have cancelled Claims 54-66 solely for the purpose of narrowing the issues between the Applicants and the Examiner and not for purposes relating to patentability or admission concerning the propriety of the pending rejections thereof. The cancellation of these claims, however, renders the rejection under 35 U.S.C. §102(e) based upon Clubb, et al as moot.

### **Summary**

Applicants have amended the present application to claim priority to a co-pending related U.S. Patent Application which claims priority to an earlier application which antedates both the Whitcher, et al and the Johnson, et al references cited under 35 U.S.C. §102(e). Applicants submit that the priority application, portions of which were previously incorporated by reference and restated herein, substantially enables the presently pending claims, as amended. The major exception to the enablement of the pending claims by the priority application is the recitation of controlling inter- and intra-granular precipitates in the deposited film. This, element, however, is neither expressly nor inherently disclosed in either of the cited anticipatory references.

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While Applicants do not believe any fees, aside from the Extension fee, are required with this response, the Director is hereby authorized to deduct any other fee required for this response from deposit account 18-2000. This page is submitted in duplicate. This paper is being concurrently filed with a Revocation of Associate Power of Attorney to Frank Z. Yang, who is no longer with the firm of Rosenbaum & Associates, P.C.

Respectfully submitted,



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Reg. No. 31,872

February 7, 2005

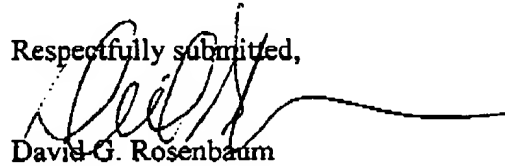
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